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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,084	06/15/2005	Frank Muller	PTT-207(402885US)	9197
7265 7590 09/02/2009 MICHAELSON & ASSOCIATES P.O. BOX 8489 RED BANK, NJ 07701-8489				
EXAMINER				
TROTTER, SCOTT S				
ART UNIT		PAPER NUMBER		
3694				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/539,084

Applicant(s)

MULLER ET AL.

Examiner

SCOTT S. TROTTER

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The Office acknowledges the receipt of Applicant's amendment, filed May 29, 2009. In response new grounds of rejection had to be issued. This rejection is made **FINAL**.

Response to Arguments

2. Applicants arguments were fully considered but were moot due to new grounds of rejection necessitated by amendment.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21-25 and 28-31 rejected under 35 U.S.C. 103(a) as being unpatentable over Bruwer et al. (U.S. Patent 5,841,866).

As per claim 21 Bruwer teaches:

A method of activating a chipcard for providing services among a terminal, accessible to a service customer, an infrastructure, comprising a network, and a server connected to the infrastructure and associated with a service provider, the chipcard having a storage medium containing an activation code and an initial challenge code, wherein the method comprises the steps of:

inserting the chipcard in the terminal, (*see at least Bruwer column 3 line 17 and abstract*. The abstract was cited to make clear that the talk of a "circuit" is a circuit on a card which is a "chipcard") the terminal being connected, via the infrastructure, to the server;

comparing, within the chipcard, an activation challenge code, received from the server and through the infrastructure and the terminal, with the initial challenge code stored in the storage medium; (*see at least Bruwer column 3 lines 18-26*) and

if the activation challenge code equals the initial challenge code, sending the activation code stored in the medium, via the terminal and the infrastructure, to the server for activating a card balance associated with the chipcard. (*see at least Bruwer column 3 lines 30-37.*)

Bruwer has the communication going between the terminal and the card rather than from the card thru the terminal to the server. But under MPEP 2144.04 making something separable is obvious therefore since the only difference is the terminal is split into a server and terminal with the terminal interfacing with the card then passing communications to the server and from the server to the card it would have been obvious to a user of ordinary skill in the art at the time the invention was made to split the terminal into a terminal and a server so that the server could maintain a central database to check the validity of requests.

As per claim 22 Bruwer teaches:

The method recited in claim 21 wherein a unique card identifier (ID), in electronic or magnetic form, is present on the chipcard. (*see at least Bruwer column 3 lines 30-44.*)

As per claim 23 Bruwer teaches:

The method recited in claim 22 wherein a result produced by the chipcard, through the comparing step, and stored in the medium shows whether the activation challenge code provided to the chipcard equals the initial challenge code present in the storage medium. (*see at least Bruwer column 3 lines 43-44*)

As per claim 24 Bruwer teaches:

The method recited in claim 23 further comprising the steps of:
receiving by the server, from the terminal and via the infrastructure, the card ID and the result; and
verifying, by the server and through a database accessible by the server, whether the result corresponds to an activation code check associated with the card ID and stored in the database. (*see at least Bruwer column 3 lines 30-44.*)

Bruwer has the communication going between the terminal and the card rather than from the card thru the terminal to the server. But under MPEP 2144.04 making something separable is obvious therefore since the only difference is the terminal is split into a server and terminal with the terminal interfacing with the card then passing communications to the server and from the server to the card it would have been obvious to a user of ordinary skill in the art at the time the invention was made to split

the terminal into a terminal and a server so that the server could maintain a central database to check the validity of requests.

As per claim 25 Bruwer teaches:

The method recited in claim 24 wherein the card ID, and the associated activation challenge code, the associated activation code check and a reducible card balance associated with the card ID are located in the database.

As per claim 25 Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961) "As to the rejection of the claims on the prior art references, we do not agree with the appellant that such structural limitations as are not disclosed by the references should be given patentable weight. This argument is applicable to claims drawn to structure and not claims drawn to a method. To be entitled to such weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here." Teaches that the structure in a method claim is not entitled to patentable weight in this case Bruwer teaches being able to verify the challenge sent to the card and the challenge received from the card which are the functional parts of the method.

As per claim 28 Bruwer teaches:

The method recited in claim 22 wherein a challenge code present on the chipcard shows status of the chipcard, and the method further comprises the step of setting the challenge code present on the chipcard to the activation challenge code

provided by the server to the chipcard. (see *Bruwer column 4 lines 46-52*. The counter status is the chipcard status.)

As per claim 29 Bruwer teaches:

The method recited in claim 28 further comprising the step, performed by the terminal, of reading out the challenge code stored on the chipcard in order to determine the status of the chipcard. (see *Bruwer column 4 lines 46-52*. The counter status is the chipcard status.)

As per claim 30 Bruwer teaches:

The method recited in claim 28 further comprising the step, performed by the server, of setting the challenge code to a predefined value C2 if a reducible card balance associated with the card I D has been exhausted. (see *Bruwer column 4 lines 60-65 and column 6 lines 22-25*. The decrement could not be successfully carried out if the count is down to zero.)

As per claim 31 Bruwer teaches:

The method recited in claim 22 further comprising the step of storing, on the chipcard, the activation challenge code provided by the server to the chipcard. (see *Bruwer column 4 lines 60-65*. Receives the next challenge and stores it.)

5. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruwer et al. (U.S. Patent 5,841,866) in view of Lebouill (U.S. Patent 7,360,078 B1).

As per claim 26 Bruwer teaches:

The method recited in claim 23 further comprising the step, performed by the chipcard, if the server has provided a correct value of the activation challenge code to the chipcard, of assigning the activation code to the result or, (*see Bruwer column 3 lines 18-26*. If the challenge was proper it provides a proper response that allows the transaction to go thru.) if not, of assigning a predefined error code E1 to the result.

While Bruwer does not explicitly teach sending an error code if authentication failed Lebouill taught sending an error code when authentication failed. (*see Lebouill column 10 lines 65–column 11 line 6*.) Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to send an error code if the authentication failed.

As per claim 27 Bruwer teaches:

The method recited in claim 26 further comprising the steps, performed by the terminal, of:
reading out and verifying the result; and
providing a report if the result equals the error code E1.

While Bruwer does not explicitly teach sending an error code if authentication failed Lebouill taught sending an error code and taking further action based on that error code when authentication failed. (*see Lebouill column 12 lines 16-27*. Resetting communications is sending a message to fix the problem which is functionally providing a report for the error code.) Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to send an error code if the

authentication failed and take further action to try to correct the problem indicated by the error code.

Conclusion

6. Any inquiry concerning this communication from the examiner should be directed to Scott S. Trotter, whose telephone number is 571-272-7366. The examiner can normally be reached on 8:30 AM – 5:00 PM, M-F.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on 571-272-6712.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9. The fax phone number for the organization where this application or proceeding is assigned are as follows:

(571) 273-8300 (Official Communications; including After Final
Communications labeled "BOX AF")

(571) 273-6705 (Draft Communications)

sst
September 2, 2009

/James P Trammell/
Supervisory Patent Examiner, Art Unit 3694

